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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/888,819

06/25/2001

Robin S. Gray

9738

7590

05/11/2004

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EXAMINER

LIU, MING HUN

ART UNIT

PAPER NUMBER

2675

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/888,819

Applicant(s)

GRAY, ROBIN S.

Examiner

Ming-Hun Liu

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-7, 10, 12, 22, 24-28, 33, 34 are rejected under 35 U.S.C. 102(b) as being unpatentable by US Patent 5,327,161 to Logan et al.

In reference to claim 1, Logan's invention sets out to combine the different components of the mouse button and the touch pad. By referring to figures 2A and 2B and the passage presented on column 3, lines 55-68, Logan teaches a mechanical button and touch pad combination. The touch pad (item 54) is integrated into a cavity of the mechanical button (entire item, highlighted by 50 and 58).

In reference to claim 2, Logan states in column 4, line 4 that the switch is a press button.

In reference to claim 5, Logan's invention teaches the use of a single stroke operation.

Claim 6 is largely rejected on the grounds presented in the rejection of claim 1. The added limitation of allowing the pointer to be repositioned without physical movement of the mouse is also anticipated by Logan (column 1, lines 65-68).

Claim 7 is rejected on the grounds offered in the rejection of claim 2.

Claim 10 is rejected on the grounds offered in the rejection of claim 1.

In reference to claim 12 and 22, Logan teaches that his invention is a mouse/touchpad combinational device (column 1, lines 10-15).

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In reference to claims 24, 26 and 27, it is obvious that Logan's invention sets out to prevent the need to drastically reposition the mouse in order to move the mouse cursor (column 1, lines 10-15).

In reference to claims 25, 28, 33 and 34, it can be seen from figures 2A and 2B that the touch pad and button wall always maintains contact during push button implementations.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4, 8, 9, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Logan.

In reference to claims 3 and 4, Logan understands that the press button can be of several types well known to the art (column 3, lines 65-66). It would have been obvious to one skilled in the art to choose a press and lock button or a sliding panel button as the preferred embodiment if such substitutions improved on the user-friendliness of Logan's invention. Furthermore, Logan explains that the push button may be programmed to include a "button down" position to maintain the drag function (column 2, lines 6-10).

Claims 8 and 9 are rejected on the grounds offered in the rejection of claim 2.

In reference to claim 29, there is no disclosed criticality as to why the touch pad must be on a backlit area. Backlighting input devices is an aesthetic design component that is regularly

implement and commonly known in the mouse art. One skilled in the art could have easily implemented a backlight by adding a simple LED to the circuitry. It would have been obvious to add a light because of the extreme conventionality of the practice that increases aesthetic value and also acts as location cue in the dark.

5. Claims 11, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan and US patent 5,530,455 to Gillick et al.

In reference to claims 11, 30 and 31, Logan teaches an invention that is similar to the one being claimed.

However, Logan does not go as far as to include a side button/touch pad at the sidewall of the mouse. Gillick on the other hand, does teach the addition of a side button.

One skilled in the art understands that additional buttons can be added to the mouse in various positions that seem most natural to a hand's grip. Placing a button/touch pad at the side of a mouse is an addition that does not change the complex circuitry, but rather just the physical position of an element.

It would have been obvious to one skilled in the art to include an additional button on the side of the mouse, because that is the position where the thumb naturally rests and allows for an additional command method.

6. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of US patent 5,936,555 to Zagnoev.

In reference to claims 13 and 14, Logan teaches a mouse system with a mechanical button that is similar to the one being claimed. However Logan does not teach the incorporation of the mouse onto a computer keyboard.

Zagnoev's invention demonstrates the well-known combination of a mouse embedded onto a keyboard.

A mouse can be easily integrated into a keyboard, simply by combining the circuitry and housing of the two disjoint components.

It would have been obvious to one skilled in art to add a mouse onto a keyboard because of its extreme conventionality and the added value of space-saving and convenience factors.

Claims 15 and 16 are rejected with the same reasoning presented in the rejection of claims 3 and 4.

Claim 17 is rejected with the same reasoning presented in the rejection of claim 10.

7. Claims 18-21, 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Logan in view of US Patent 5,473,347 to Collas et al.

In reference to claims 18-21, 23 and 32, Logan teaches a mouse system that resembles the claimed invention however he does not incorporate his invention onto the sidewall of a keyboard.

Much like the reasoning offered in the rejection of claim 11, placing mouse buttons on the sidewall of a computer keyboard is also very customary in the art.

As Collas describes in the abstract of his invention, mouse buttons can be placed on the side of the keyboard for simpler, no natural feel for the user.

As for claims 18-20 and 32, it must be noted that even though Collas' invention deals primarily to laptop keyboards, one skilled in the art understands that an improvement on a laptop keyboard is easily translated to a stand-alone desktop computer keyboard.

### ***Response to Arguments***

8. Applicant's arguments with respect to claim 1-34 have been considered but are moot in view of the new ground(s) of rejection.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ming-Hun Liu whose telephone number is 703-305-8488. The examiner can normally be reached on Mon-Fri.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ming-Hun Liu

  
DENNIS-DOON CHOW  
PRIMARY EXAMINER